

REMARKS

Claim 27 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 7-8, and 27 are rejected under 35 U.S.C. § 102(e) as being anticipated by Jensen et al. (U.S. Patent No. 6,589,514). Claims 1, 7-8, 11 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tahitian Noni Products (<http://www.noni-now.com>, copyright 1998 – 2003) by itself or in view of JP 2000-095663 to Kondo et al.; Claims 1, 7-8, 11-12, 22 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tahitian Noni Products (<http://www.noni-now.com>, copyright 1998 – 2003) in view of Pelle et al. (U.S. Patent No. 6,136,301). Claims 1, 7-8, 11, and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 2000-095663 to Kondo et al., by itself or in view of Elkins (Hawaiian Noni, 1998). Claims 11-12 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 2000-095663 to Kondo et al., by itself or in view of Elkins in further view of Lane (U.S. Patent No. 5,503,825). Claims 1, 7-8, and 27 are rejected under the judicially created doctrine of obviousness – type double patenting as being unpatentable over claims of U.S. Patent No. 6,589,414.

Request for Information Under 37 C.F.R. 1.105

The Examiner has indicated that Morinda, Inc. introduced a lip balm in 1999 containing noni which constitutes prior art, but that the exact composition of the lip balm is not disclosed on the web site. The lip balm was first developed and released as a product some time after May 26, 2000. In its original form, the lip balm contained petrolatum, TAHITIAN NONI® oil, ozokerite, octyl methoxycinnamat, sorbitan oleate, benzophenone -3, beeswax, paraffin, canola oil, shea butter, propylparaben, tocopheryl acetate (vitamin E acetate), sweet almond oil, macadamia ternifolia seed oil, kukui nut oil, fragrance, butylated hydroxyanisole, propyl gallate, and citric

acid. Because the product was not on sale more than one year prior the filing of the present application, the on-sale bar of section 102 would not apply in this instance. Particular care was taken to insure that this application was filed prior to the onset of a statutory bar. It is unclear to the applicant where the Examiner has acquired information that the lip balm was on sale in the United States in 1999, and this does not accord with records kept by Morinda, Inc. If the Examiner requires additional information regarding the content of the lip balm as originally sold or the date of first sale in the United States, the Examiner is invited to request such information.

Claim Rejections Under 35 U.S.C. § 112

The Examiner has rejected claim 27 as being indefinite. Applicant has amended claim 27 to recite “each present between about 0.1 to 1.0.” Applicant submits that this amendment ameliorates the Examiner’s concern that it is not possible to have an ingredient in amount of 0 %.

Claim Rejections Under 35 U.S.C. § 102

Examiner has rejected claims 1, 7-8, and 27 under 35 U.S.C. § 102(e) as being anticipated by Jensen et al. The invention disclosed, but not claimed in the reference is derived from the inventor of this application and is thus not an invention “by another.” Accordingly, applicant submits that the Jensen reference is not prior art and may not be utilized to render the present invention unpatentable. Claude Jarakae Jensen has been supplied with a declaration under 37 C.F.R. 1.32. The undersigned will forward the executed declaration to the Examiner in a Supplemental Response when it is received by our office.

Claim Rejections Under 35 U.S.C. § 103

At least for the reasons set forth below, Applicant submits that the relevant prior art fails both to teach or suggest all the claim limitations, and to clearly and particularly suggest the combination indicated by the Examiner; thus, Applicant's claims are not obvious in view of the prior art references.

1. Rejection Under noni-now.com in View of Kondo.

Noni-now was not available as a reference more than one year prior to the filing date of the present application, and is thus not an appropriate reference under 35 U.S.C. § 103. Applicant submits that the advertisement was improperly cited as prior art due to the Examiner wrongfully attributing the 1998-2003 copyright date to the advertisement of Tahitian Noni® lip balm, Tahitian Noni® skin supplement and Tahitian Trend® Plan 40 body balance cream (collectively, the "Noni Products"), rather than to the noni-now website to which it refers. The advertisements for the noni products were added to the website less than one year before the April 20, 2001 filing date of the present application, and thus do not qualify as prior art under section 103. An affidavit to this effect is available upon request. Because the noni-now reference is not appropriate as a prior art reference, the combination of Kondo and noni-now do not teach or suggest every element of the present claims, and thus the present invention is not obvious over the combination.

2. Noni-now in view of Pelle et al.

As discussed above, the noni-now reference is not appropriate as a prior art reference. Accordingly, the combination of Pelle and noni-now do not teach or suggest every element of the present claims, and thus the present invention is not obvious over the combination.

3. Kondo by itself or in view of Elkins

The Examiner has rejected claims 1, 7-8, 11 and 27 under 35 U.S.C. 103(a) as being unpatentable over Kondo in view of Elkins. Applicant has amended claim 1 to include the limitations found in dependent claim 12 and thus the present invention is not obvious over the combination.

4. Kondo by itself or in view of Elkins in further view of Lane.

In as much as Applicant's amendments to the claims obviates the rejection of independent claim 1 under Kondo by itself or in view of Elkins, Applicant maintains the combination of Kondo in view of Elkins in further view of Lane also fails to establish a *prima facie* case of obviousness because Lane also fails to teach the specific ranges recited by the claims of the present invention for the quantity of ozokerite. Lane simply provides a laundry list of examples of cosmetic vehicles which do not react with aloe vera and are otherwise non-toxic. Because Lane fails to disclose the narrow range claimed in the present application with "sufficient specificity," Lane in combination with Kondo and Elkins fails to teach every element of the present invention and thus does not render the claims of the present invention obvious.

Double Patenting

Enclosed please find a terminal disclaimer in compliance with 37 C.F.R. 1.321(c) executed by a registered attorney for the applicant. Applicant respectfully submits that the terminal disclaimer overcomes the obviousness-type double patenting rejection.

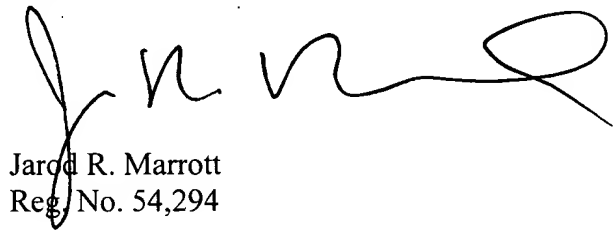
CONCLUSION

Applicants submit that the amendments made herein do not add new matter and that the claims are now in condition for allowance. Accordingly, Applicants request favorable reconsideration. If the Examiner has any questions or concerns regarding this communication, the Examiner is invited to call the undersigned.

Dated this 22 day of July, 2005.

Respectfully submitted,

KIRTON & McCONKIE

A handwritten signature in black ink, appearing to read 'Jarod R. Marrott', with a stylized, flowing script.

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